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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,013	12/18/2001	Kolazi S. Narayanan	FDN-2692	2430

7590

08/01/2003

## INTERNATIONAL SPECIALTY PRODUCTS

Attn: William J. Davis, Esq.  
Building No. 10, Legal Department  
1361 Alps Road  
Wayne, NJ 07470

EXAMINER

METZMAIER, DANIEL S

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 08/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/023,013

Applicant(s)

NARAYANAN ET AL

Examiner

Daniel S. Metzmaier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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### **DETAILED ACTION**

Claims 1-12 are pending.

#### ***Claim Objections***

1. Claim 12 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim.

Claim 12 is improper because it depends on multiple dependent claim 10. See MPEP § 608.01(n). Accordingly, the claim 12<sup>1</sup> has not been further treated on the merits.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-11 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 9 and 10 are indefinite because claims 1, 9 and 10 include concentrations without designating what said concentrations is based, *ie.*, weight percent. Said basis should be indicated in the claims. Applicants should indicate wherein the originally filed specification they are relying for the basis of the amendments to correct this issue.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 5-9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Jon et al, US 5,968,990. Jon et al (column 2, lines 5-57) disclose compositions and concentrations to make a water-dilutable microemulsion concentrate of an agriculturally active ingredient including Amitraz. Said concentrates and microemulsions read on the claims. Jon et al (column 2, lines 39-45) discloses the buffering of Amitraz to pH 7 and the stability thereof. The addition of a buffering agent as claimed is inherent to the use of the Jon et al compositions as a pour-on dip or spray formulation.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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<sup>1</sup> Claim 12 is improper for further treatment on the merits. If claim 12 is amended to place it in proper form, claim 12 may be subject to restriction as a patentably distinct invention.

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jon et al, US 5,968,990, in view of The Procter & Gamble Company, WO 01/60961 A1. Jon et al (column 2, lines 5-57) disclose compositions and concentrations to make a water-dilutable microemulsion concentrate of an agriculturally active ingredient including Amitraz as set forth in the above anticipation rejection.

To the extent Jon et al lacks the disclosure of a specific buffering agent, The Procter & Gamble Company discloses (page 1, lines 24-30; page 2, lines 1-27; page 3, lines 3-6; and page 5, line 16 to page 8, line 24; particularly page 7, lines 13, 1720, 25, and 29; and page 8, lines 2, 5, 10 and 17-24) the use of alkali metal and boric, carbonic, glutaric, malic, malonic, phenol, and succinic acids in forming buffers for compositions employing polyoxyalkylene polysiloxanes.

The Procter & Gamble Company (page 1, lines 24-30) cites Jon et al '990 as being hazy when the concentrate employing polyoxyalkylene polysiloxane wetting agents are diluted. The Procter & Gamble Company (page 2, lines 1-27) teaches compositions employing polyoxyalkylene polysiloxanes with a buffering agent wherein the pH is maintained between 4 and 10 are stable.

These references are combinable because Jon et al '990 is specifically cited in The Procter & Gamble Company. It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ commonly known buffers in stabilizing the active Amitraz compositions taught in the Jon et al reference to form a

more stable composition as taught in The Procter & Gamble Company reference.

9. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jon et al, US 5,968,990, in view of Newton et al, US 5,547,918 A. Jon et al (column 2, lines 5-57) disclose compositions and concentrations to make a water-dilutable microemulsion concentrate of an agriculturally active ingredient including Amitraz as set forth in the above anticipation rejection.

To the extent Jon et al lacks the disclosure of a specific buffering agent, Newton et al (abstract, column 2, lines 35-42 and 43-62 ; column 6, lines 44 and 60, to column 7, line 16 ; column 4, line 57, to column 6, line 16 et seq ; particularly column 5, line 62, to column 6, line 6 ; and examples) teaches aqueous agrochemical suspensions employing a structured surfactant (column 2, lines 35-42), possibly amitraz as a suitable active agent (column 6, line 44), aromatic oils (column 6, lines 60 et seq) and electrolyte including carbonates and bicarbonates optionally with alkali or ammonium hydroxide to improve stability by adjusting the pH (column 5, line 62, to column 6, line 6). Newton et al (column 7, lines 12-16) further teaches the use of oil concentrations overlapping the range of claim 10.

These references are combinable because they teach compositions employing amitraz and methods of making compositions more stable. It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to employ commonly known buffers in stabilizing the active Amitraz compositions taught in the Jon et al '990 reference to form a more stable composition as taught in Newton et al reference.

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Furthermore, Newton et al (column 2, lines 43-61) teaches the incorporation of the oils improve the stability of the suspended compositions. It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ aromatic oils as a conventional additive to the active Amitraz compositions taught in the Jon et al '990 reference to form a more stable composition as taught in Newton et al reference.

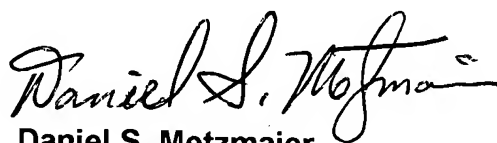
**Conclusion**

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (703) 308-0451. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on (703) 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Daniel S. Metzmaier  
Primary Examiner  
Art Unit 1712

DSM  
July 23, 2003